

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte S. KENNETH KIRN and MICHAEL B. FOX

Appeal No. 1999-1568
Application No. 29/063,397¹

ON BRIEF

Before OWENS, NASE, and CARMICHAEL, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the single design claim pending in this design application.

We REVERSE.

¹ Application for patent filed December 6, 1996.

BACKGROUND

The appellants' invention relates to a design for a play tunnel. The claim on appeal is:

The ornamental design for a PLAY TUNNEL as shown and described.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Morris et al. (Morris)	5,496,232	March 5,
1996		

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Morris.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 8, mailed July 21, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 7, filed April 17, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' drawings, specification and claim and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we have determined that the examiner's rejection of the appellants' design claim under 35 U.S.C. § 103 as being unpatentable over Morris cannot be sustained.

At the outset, we keep in mind that, in a rejection of a design claim under 35 U.S.C. § 103, there is a requirement that there must be a single basic reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) and In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The examiner relies upon the appearance of the tunnel 64 of Morris as the basic design reference, i.e., as a "Rosen"

reference (answer, pp. 2 & 3). The appellants argue (brief, pp. 6-7) that the tunnel of Morris does not have the basic design characteristics as the claimed design. We agree with the examiner that Morris is a basic design reference.

At this point, we note that once such a basic design reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. See In re Harvey, 12 F.3d at 1063, 29 USPQ2d at 1208. These secondary references may only be used to modify the basic design reference if they are so related to the basic design reference that the appearance of certain ornamental features in one would have suggested the application of those features to the other. See In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996). However, such modifications cannot destroy fundamental characteristics of the basic design reference. See In re Rosen, supra. Thus, the focus in a design patent obviousness inquiry should be on visual appearances rather than design concepts. See In re Harvey, 12 F.3d at 1064, 29 USPQ2d at 1208.

The difficulty we have with the examiner's rejection is that the examiner concludes that since transparent materials are known it would have been obvious to modify the tunnel of Morris to be transparent (answer, pp. 3-5). We do not agree. First, the change of Morris' tunnel from being opaque to being transparent is more than a de minimis change since the net effect of such change does affect the appearance of the claimed design as a whole and the impression that the design would make to the eye of a designer of ordinary skill. See In re Carter, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982). Second, we see no suggestion of why a designer of ordinary skill would have modified Morris' tunnel to be transparent. In our view, the mere fact that transparent materials existed would not have made it obvious to a designer of ordinary skill to have changed the basic visual appearance created by Morris' opaque tunnel to a totally different visual appearance (i.e., a transparent tunnel).²

² The examiner should have applied prior art to establish why it would have been obvious to a designer of ordinary skill to make the tunnel of Morris transparent.

Moreover, it is our opinion that even if Morris' tunnel were modified to be transparent, it would not have resulted in the overall design claimed by the appellants. In that regard, it is our opinion that the visual impression of the appellants' transparent cylinder, non-transparent border and transparent end panels is significantly different from the visual impression of Morris' tunnel even if modified to be transparent. Specifically, as shown in the Figures 1, 3 and 4, the appellants' transparent cylinder is formed from two pieces of transparent material. Each piece of transparent material has an opaque semicircular band adjacent each transparent end panel and two opaque longitudinal ribs (at the top and bottom of each piece of transparent material as shown in Figure 4). Thus, the overall visual impression of the appellants' play tunnel (as viewed from the side) is that of a transparent cylinder between two transparent end panels wherein the transparent cylinder has an opaque border formed from the two opaque semicircular bands and the two opaque longitudinal ribs. This opaque border is more than a de minimis change since the net effect of such change does affect the appearance of the claimed design as a whole and the

impression that the design would make to the eye of a designer of ordinary skill. Clearly, such overall appearance of the claimed design as a whole is not suggested by Morris' tunnel.

For the reasons stated above, the decision of the examiner to reject the claim under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject the claim under 35 U.S.C. § 103 is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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APPEAL NO. 1999-1568 - JUDGE NASE
APPLICATION NO. 29/063,397

APJ NASE

APJ OWENS

APJ CARMICHAEL

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 23 Apr 99

FINAL TYPED: